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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,108	02/17/2000	Mary M. Swenson	54682 USA 6A	7637

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EXAMINER

LEWIS, KIM M

ART UNIT PAPER NUMBER

3743

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/507,108	<b>Applicant(s)</b> SWENSON, MARY M.	
	<b>Examiner</b> Kim M. Lewis	<b>Art Unit</b> 3743	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-38 is/are allowed.
- 6) ☐ Claim(s) 1,8-12 and 15-23 is/are rejected.
- 7) ☒ Claim(s) 2-7, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/29/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> .                  |

## DETAILED ACTION

**Prosecution of this application is reopened in light of applicant's remarks.**

### ***Response to Amendment***

1. The amendment filed on 10/29/04 has been received and made of record in the application file wrapper.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 8-10, 11, 15-18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,292,777 ("DesMarais et al.") in view of U.S. Patent No. 4,609,584 ("Cutler et al.").

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As regards claim 1, DesMarais et al. disclose applicant's claimed invention. More specifically, DesMarais et al. disclose a medical article comprising a liquid-impervious, moisture-vapor permeable polymeric film (backing sheet 71) having directly bonded thereto an absorbent, substantially nonswellable foam comprising a hydrophobic polymer (Abstract, col. 2, lines 49-56, col. 4, lines 38-47, col. 7, lines 19-23 and col. 13, lines 31-50). DesMarais et al. fail to teach the backing sheet is moisture-vapor permeable. Cutler et al., however, teaches that it is conventional in the diaper art to provide diapers with a liquid-impervious, moisture-vapor permeable polymeric film backing sheet in order to allow body fluids to evaporate (col. 3, lines 42-49).

In view of Cutler et al., it would have been obvious to one having ordinary skill in the art to modify DesMarais et al. to include a liquid-impervious, moisture-vapor permeable polymeric film backing sheet rather than a liquid-impermeable backing sheet order to allow body fluids to evaporate from the diaper.

As regards claims 8 and 9, both DesMarais et al. and Cutler et al. fail to disclose the claimed wet and dry moisture transmission rates of the film (backing sheet) and thickness of the film (backing sheet). However, the examiner contends that since both the wet and dry moisture transmission rates of the film (backing sheet) depend upon characteristics such as, for example, the thickness of the material, it would have been obvious to one having ordinary skill in the art to design the modified device of DesMarais et al. with a film (backing sheet) having the desired thickness which provides

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the desired wet and dry transmission rates in order to allow a desired amount of breathability of the diaper.

As regards claim 10, as can be seen from Fig. 2, the film layer (backing sheet 71) is one layer.

As regards claim 11, Cutler et al. disclose the backing sheet material as being polyethylene. However, it has been held that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

As such, it would have been obvious to one having ordinary skill in the art select polyurethane as the backing material depending upon which characteristic and/or properties of the backing sheet are desired.

As regards claim 12, in Example 4 of DesMarais et al., the film (backing sheet) is 0.03 mm, which converts to 30 microns.

As regards claims 15 and 16, DesMarais et al. disclose the use of hydrophobic foams in the Abstract as well as throughout the specification. Additionally disclosed is information regards the pores (open cells) of the foam at col. 12, lines 26-40).

As regards claim 17, DesMarais et al. fail to disclose printed graphics on the film (backing sheet). However, it is conventionally known to print graphics such as (Sesame Street Character and Disney Characters) on the backing sheets of diapers as an ornamental design choice (see for example, U.S. Patent No. 5,695,855). As such, it

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would have been *prima facie* obvious to one having ordinary skill in the art to provide the backing sheet of DesMarais et al. with printed graphics as an ornamental design choice.

Regarding claim 18, as can be seen from Fig. 2, the backing clearly extends beyond a periphery of the foam.

As regards claim 22, DesMarais et al. fail to teach that the foam layer is cast directly onto the film (backing sheet) layer. Absent a critical and/or a showing of unexpected results derived from casting the foam layer directly on the film layer, the examiner contends that casting the foam layer directly on the film layer is an obvious design choice which does not patentably distinguish applicant's invention.

As regards claim 23, col. 1, lines 10-16 of DesMarais et al. disclose that that the invention disclosed therein are suitable for bandages, a type of wound dressing.

5. Claims 1 and 19 and rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,409,472 ("Rawlings et al.") in view of DesMarais et al.

As regards claim 19, Rawlings et al. disclose an adhesive polymeric dressing, which substantially discloses applicant's claimed invention. More specifically, Rawlings et al. disclose a dressing comprising a liquid impervious water-vapor permeable film material (3) (col. 8, lines 65-66 and col. 12, lines 65-66) having directly bonded thereto an absorbent foam (21). As can be seen in Figs. 2 and 11b, the adhesive is disposed on the surface to which the foam is bonded around the periphery of the foam.

Rawlings et al. fail to teach a nonswellable foam comprising a hydrophobic polymer. DesMarais et al., however, teaches it is conventional to use nonswellable foams comprising a hydrophobic polymer on bandages. In view of Rawlings et al., it would have been obvious to one having ordinary skill in the art to substitute the foam layer of Rawlings et al. for the foam layer of DesMarais et al. in order to provide an highly absorbent foam material that does not swell and consequently does not apply pressure to the user when wetted by absorption of wound exudate.

6. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over DesMarais et al. in view of Cutler et al. as applied to claim 1 above, and in further view of U.S. Patent No. 5,695,855 ("Yeo et al.").

As regards claims 20 and 21, both DesMarais et al. and Cutler et al. fail to teach film (backing sheet) includes a nonwoven, woven or knit web bonded to a surface opposite the foam. However, Yeo et al. teach a nonwoven web for bonding to the film layer (backing sheet) of a diaper for the purpose of printing indicia, instructions or general patterns directly thereon (*i.e.*, to make the diaper attractive and fun) (col. 3, lines 34-50).

In view of Yeo et al., it would have been obvious to add a nonwoven web to the modified diaper of DesMarais et al. for the purpose of printing indicia, instructions or general patterns directly thereon to make the diaper attractive and fun.

As to claim 21 and the adhesive, Yeo et al. is silent as to how the nonwoven web is adhered to the backing of the diaper. However, the examiner contends that it

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would have been *prima facie* obvious to adhere the nonwoven web to the backing of a diaper via adhesive since adhesive is a commonly known and used adhering agent.

***Allowable Subject Matter***

7. Claims 2-7, 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 24-38 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter:

The claims are considered definite as the examiner cannot show by clear and convincing evidence that an expert upon consulting the specification would not be able to determine the scope of the claim. See in general *W. L. Gore & Associates v. Gorluck, Inc.*, 721 F. 2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 US 851 (1984).

The claims are considered patentable over the prior art as the examiner can not show by clear and convincing evidence that the claim's functional or characteristic recitations necessarily flows and/or is inevitably present in the teachings of the prior art considered by the examiner. That is since there are other attributes undisclosed in the prior art that necessarily effect the functional or characteristics claimed, the application of prior art is not warranted, see *Ex parte Latimore*, (Bd. Pat. App. & Inter. 3/21/1994), *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).



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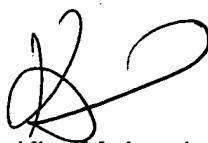
***Response to Arguments***

10. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571)272-4796. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett, can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kim M. Lewis  
Primary Examiner  
Art Unit 3743

kml  
January 10, 2004